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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HSU, RYAN

ART UNIT

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3714

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,806	Applicant(s) ENGLMAN ET AL.	
	Examiner RYAN HSU	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-66 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-66 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/23/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the response to restriction filed on 2/4/08, applicant has elected group I (claims 35-43 and 54-58). Claims 67-68 are canceled without prejudice and claims of group II (claims 44-53, 59-66, and 69) are withdrawn from prosecution. Claims 35-43 and 54-58 are pending in the current application.

Election/Restrictions

Claims 44-53, 59-66 and 69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected election, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/4/08.

Claims 67-68 are canceled from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/4/08.

In light of the arguments made for traversing the restriction requirement towards the claims of group II the Examiner has found the arguments convincing however, it is noted that if a diversion of subject matter continues between these two subcombinations that the Examiner would reserve the right to make another restriction requirement at the time. For the purposes to expedite prosecution the claims of group I and group II have been examined below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3714

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 6,648,754 B2).

Regarding claims 35 and 54, Baerlocher teaches a method of playing a bonus game with a bonus payoff comprising: conducting a wagering game at a gaming terminal and activating the bonus game entry award and displaying a plurality of player-selectable game elements during a bonus game and via player inputs selecting at least one of the plurality of player-selectable game elements and awarding the bonus game payoff in response to the player selecting a certain set of player-selectable game elements (*see Fig. 5(a-c) and the related description thereof*). However, Baerlocher is silent with respect to an embodiment where the bonus game is specified as a progressive game. Progressive games or pari-mutuel games are well known in the art to incorporate a jackpot or bonus award using a percentage of the wagers made by a player at a game machine. These progressive games have also been adapted to be used with networked gaming machines and therefore can take a percentage of several game machines at the same time to provide the player with a large jackpot or credit award. Progressive prizes however only determine the source of a credit award in a game and does not actually change or alter the play of a game. Furthermore, progressive prizes are old and well known in the art and have been used to provide large bonus prizes to be awarded to users. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the expected advantage of a progressive payoff instead of the bonus game payoff that is taught in Baerlocher so that a player could be offered a larger bonus prize.

Art Unit: 3714

Several examples of Progressive bonus prizes are shown in the following patents:

(Mullins - (US 6,210,276 B1), Wood (US 5,286,023), and Okuda et al. (US 6,224,484 B1)).

Regarding claims 36 and 55, Baerlocher teaches a player-selectable game element including a continue-game element that allows for the continuation of the bonus game and a stop-game element that stops the bonus game and upon the receiving of a continue-game input providing the player with an award (*see Fig. 5(a-c) and the related description thereof*).

Regarding claims 37 and 45, Baerlocher teaches a method wherein the sequentially selecting one of the continue-game elements increases the bonus game payoff (*see elements [30,32, 100,122] of Fig. 5c and the related description thereof*).

Regarding claims 38-39, 56 and 62-63, Baerlocher teaches a method wherein the bonus game includes a first and second game payoff wherein the second game payoff is higher than the first game payoff and selecting a predetermined number of continue-game elements or a predetermined number of level-increasing elements allow the player to achieve a second game payoff (*see Fig. 6 and the related description thereof*).

Regarding claim 41, Baerlocher teaches a bonus game wherein a player selects from a plurality of bonus game qualifying items and they are displayed on the game machine display in order to determine the overall payoff for the user (*see Fig. 6 and the related description thereof*). However, Baerlocher is silent with respect to these qualifying items as been video envelopes. Video Envelopes in the instant invention simply act as item icons or display or theme art and do not would be a simply matter of design choice by the game programmer. As it would have been obvious to one of

Art Unit: 3714

ordinary skill in the art at the time the invention was made to incorporate a video envelope design into the player selectable components of Baerlocher's bonus game and expect the operation of the game to still meet the limitations of the instant invention.

Regarding claims 42 and 58, Baerlocher teaches a method wherein the game includes first and second game payoffs and the first and second game payoffs are displayed on signage located above the gaming terminal (*see Fig. 6 and the related description thereof*). If the applicant's contends Baerlocher's ability to display the progressive bonus outputs the Examiner would like to enact OFFICIAL NOTICE that the display of awards on a signage display is extremely old and well known in the art. Furthermore, the Examiner cites the following references as examples of a signage device **(Okuda et al. (US 6,224,484 B1) - Figs. 2-3 and the related description thereof; Wood (US 5,286,023) -Figs. 1 and 6 and the related description thereof).**

Regarding claims 43, 57-58 and 65, Baerlocher teaches a method wherein the steps of conducting, achieving, activating, and displaying and determining a randomly selected outcome are performed by a CPU internal or local to the gaming terminal (*see col. 5: ln 60-col. 6: ln 7*).

Regarding claims 44, 59 and 69, Baerlocher teaches a method of playing a bonus game at a gaming terminal that has a first bonus game payoff and a second bonus game payoff comprising: receiving from the gaming terminal at least one player input during the bonus game and in response to the receiving of player inputs determining whether the player input achieves a first bonus game payoff or a second bonus game payoff and the second bonus game payoff being greater than the first bonus game payoff (*see Fig. 5(a-c) and the related description thereof*). Additionally, Baerlocher teaches a first selection of

Art Unit: 3714

player inputs yielding a first bonus game payoff and a second selection of player inputs yielding a second bonus game payoff and awarding the player a corresponding one of the first and second bonus game payoffs (*see Fig. 6 and the related description thereof*).

However, Baerlocher is silent with respect to an embodiment where the bonus game is specified as a progressive game. Progressive games or pari-mutuel games are well known in the art to incorporate a jackpot or bonus award using a percentage of the wagers made by a player at a game machine. These progressive games have also been adapted to be used with networked gaming machines and therefore can take a percentage of several game machines at the same time to provide the player with a large jackpot or credit award. Progressive prizes however only determine the source of a credit award in a game and does not actually change or alter the play of a game. Furthermore, progressive prizes are old and well known in the art and have been used to provide large bonus prizes to be awarded to users. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the expected advantage of a progressive payoff instead of the bonus game payoff that is taught in Baerlocher so that a player could be offered a larger bonus prize. Several examples of Progressive bonus prizes are shown in the following patents: (Mullins - (US 6,210,276 B1), Wood (US 5,286,023), and Okuda et al. (US 6,224,484 B1)).

Regarding claims 46-47 and 60-61, Baerlocher teaches a method wherein the gaming terminal includes a display and the display for displaying a plurality of player-selectable game elements and at least one player input corresponding to the one of the plurality of player-selectable game elements (*see elements [108(a-x)] of Fig. 5c and the*

Art Unit: 3714

related description thereof). Additionally, Baerlocher teaches the activation of a touch screen positioned over one of the plurality of player-selectable game elements (*see 'touch screen' and 'touch screen controller' [50-52] Fig. 2 and the related description thereof*). Furthermore, the player selectable elements when selected are opened to reveal an outcome (*see Fig. 5(a-c) and the related description thereof*).

Regarding claims 52-53, Baerlocher teaches a method wherein the determining is performed by a CPU internal to the gaming terminal or external to the gaming terminal (*see col. 5: ln 60-col. 6: ln 7*).

Regarding claim 64, Baerlocher teaches a continue-game element that includes a credit element the credit element provides the player of the bonus game with a credit award (*see Fig. 4(a-b) and the related description thereof*).

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. as applied to claims above, and further in view of Okuda et al. (US 6,224,484 B1).

Regarding claim 66, Baerlocher teaches a gaming system that allows a player to be offered a progressive game payoff. However, Baerlocher is silent with respect to a gaming terminal that includes a connection port. In an analogous gaming patent, Okuda teaches a gaming terminal that includes a connection port for coupling the gaming terminal to signage located adjacent to the gaming terminal for displaying a progressive game payoff (*see Fig. 1 and the related description thereof*). One would be motivated to incorporate a connection port into the game terminal of Baerlocher in order to allow the

Art Unit: 3714

gaming device to display signage information and attract customers. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Okuda with that of Baerlocher to create the expected result of a gaming machine that could communicate with an outside display device and attract customers.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

April 7, 2008

/Robert E Pezzuto/

Supervisory Patent Examiner, Art Unit 3714

Art Unit: 3714